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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,959	12/15/2003	Karin Drechsel	1/1156-1-C1	3400

28501 7590 05/15/2007
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EXAMINER

HAGHIGHATIAN, MINA

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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05/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,959

Applicant(s)

DRECHSEL ET AL.

Examiner

Mina Haghighatian

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-31 and 38-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-31 and 38-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of the Amendments and Remarks filed on 03/12/07.

Claims 1, 22, 23 and 71-72 have been amended and claim 21 has been cancelled. No new claims added. Accordingly, claims **1-20, 22-31 and 38-95** are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-20, 22-31 and 38-95** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/068,134 (US 20050147564). Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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instant claims would have been anticipated by the reference claims. The claims of the co-pending application are drawn to a formulation comprising a first active agent comprising a tiotropium salt in a concentration range of between 0.0005% and 5% by weight, a steroid, a solvent such as water or ethanol and a preservative, wherein the formulation has a pH of from 2.0 to 3.5. The claims of instant application are drawn to a similar preparation. The difference is that the steroid is not required.

This is a provisional obviousness-type double patenting rejection.

Claims **1-20, 22-31 and 38-95** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/730,796 (US 20050058606). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been anticipated by the reference claims. The claims of the co-pending application are drawn to a formulation comprising a tiotropium salt (in a concentration range of between 0.00008% and 0.4% by weight), an HFC propellant, a solvent and an organic or inorganic acid to adjust the pH to a range from 2.5 to 4.5. The claims of instant application are drawn to a similar preparation. The difference is that that the concentration range of tiotropium is slightly different and a propellant is not required.

This is a provisional obviousness-type double patenting rejection.

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Claims **1-20, 22-31 and 38-95** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/392,558 (US 20040019073). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been anticipated by the reference claims. The claims of the co-pending application are drawn to a formulation comprising a tiotropium salt in a concentration range of between 0.01 and 0.06 g per 100 ml of formulation, a solvent such as water and a preservative, wherein the formulation has a pH of from 2.7 to 3.1. The claims of instant application are drawn to a similar preparation. The difference is that the concentration range of tiotropium is slightly different.

This is a provisional obviousness-type double patenting rejection.

Claims **1-20, 22-31 and 38-95** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/267,354 (US 20060057074). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been anticipated by the reference claims. The claims of the co-pending application are drawn to a formulation comprising a first active agent comprising a tiotropium salt, a steroid, a betamimetic and a solvent such as water or ethanol. The preparation has a pH of from 2.0 to 7.0 (claim 17). The claims of instant application are drawn to a similar preparation. The difference is that the steroid and the betamimetic are not required.

This is a provisional obviousness-type double patenting rejection.

Claims **1-20, 22-31 and 38-95** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/006,940 (US 20050148562). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims would have been obvious over the reference claims. Instant claims are drawn to formulations comprising an anticholinergic, preferably tiotropium and a second active agent such as a steroid. Formulations can be in a solution form and thus require a solvent. The preferred pH range is from 2 to 7 (see e.g. claims 114 and 229). The claims of instant application are drawn to a similar preparation. The difference is that the second active agent such as steroid is not required.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

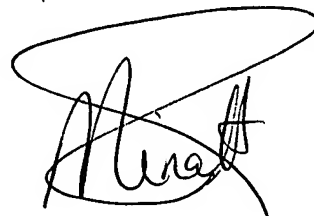
Applicant's arguments, filed 3/12/07, with respect to rejection under 35 USC 102(b) have been fully considered and are persuasive. The said rejections are withdrawn. The obviousness-type double patenting rejection over US Patent 6,890,517 has been overcome with the submission and approval of a terminal disclaimer.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 571-272-0615. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Mina Haghighatian', enclosed within a large, loopy oval shape.

Mina Haghighatian
Patent Examiner
May 14, 2007